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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77617272
Applicant	Glassflake International Inc.
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Submission	Reply Brief
Attachments	GLASSFLAKE, Tmk. Appl. 77-617,272-Reply Appeal Brief (2-8-2011).PDF (7 pages)(473959 bytes)
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Date	02/08/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

***In re Application of:* GLASSFLAKE INTERNATIONAL, INC.**

SERIAL NO.: 77/617,272

FILED: NOVEMBER 19, 2008

MARK: GLASSFLAKE

INTERNATIONAL CLASSES: 1, 2, 17

TRADEMARK ATTORNEY: DREW LEASER/LAW OFFICE 112

REPLY BRIEF

Hon. Commissioner for Trademarks
United States Patent and Trademark Office
P. O. Box 1451
Alexandria, Virginia 22313-1451

To the Trademark Trial and Appeal Board:

I. Introduction

On December 17, 2010, Applicant, Glassflake International Inc., Appellant herein, timely filed a *Notice of Appeal* from the final refusal-to-register, and on January 13, 2011, Appellant filed its supporting *Appeal Brief*. On January 25, 2011, the Examining Attorney filed his responsive *Appeal Brief*. Appellant now files its *Reply Brief* and respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision that Appellant's "GLASSFLAKE" trademark is a generic term incapable of distinguishing source and should, instead, hold that Appellant's mark is

“merely descriptive” and may eventually acquire distinctiveness, thereby justifying registration on the Supplemental Register at this time.

II. Applicant’s Rebuttal to the Examining Attorney’s Appeal Brief

The gist of the Examining Attorney’s contention that Appellant’s “GLASS-FLAKE” trademark is generic, as opposed to “merely descriptive,” and therefore unregistrable is that Appellant’s goods have “glass flakes” as an ingredient thereof. Specifically, the Examining Attorney’s “Argument” section of his *Appeal Brief* commences with the statement that “[a] word or term that is the name of key ingredient, characteristic or feature of the goods can be generic for those goods and thus, incapable of distinguishing source,” and includes citations to several C.C.P.A. and T.T.A.B. cases.

Extensive case law, however, exists in support of Appellant’s contention that a mark that references an “ingredient” of one’s goods is, in fact, “merely descriptive” of such goods, rather than generic. *See, In re Abcor Development Corporation*, 588 F.2d 811, 813, 200 USPQ 215, 217-218 (C.C.P.A. 1978) (“In early cases the Supreme Court considered whether the mark describes the ingredients, qualities, or characteristics of the goods. This court has applied the same test [for determining whether a mark is ‘merely descriptive’].” (footnotes omitted)); *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1616 (T.T.A.B. 2010) (“A term is merely descriptive of goods or services, * * * if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services.”); *Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1037 (T.T.A.B. 2010); *Anheuser-*

Busch Inc. v. Holt, 92 USPQ2d 1101, 1105 (T.T.A.B. 2009) (same); In re Carlson, 91 USPQ2d 1198, 1199 (T.T.A.B. 2009) (same); In re Litehouse Inc., 82 USPQ2d 1471, 1472 (T.T.A.B. 2007) (same); In re Viventia Biotech Inc., 80 USPQ2d 1376 (T.T.A.B. 2006) (same); In re Box Solutions Corp., 79 USPQ2d 1953, 1954 (T.T.A.B. 2006) (same); In re Classic Media Inc., 78 USPQ2d 1699, 1700 (T.T.A.B. 2006) (same); In re Finisar Corp., 78 USPQ2d 1618, 1619 (T.T.A.B. 2006) (same); In re Hunter Fan Co., 78 USPQ2d 1474, 1475 (T.T.A.B. 2006) (same); In re The Place Inc., 76 USPQ2d 1467 (T.T.A.B. 2005); In re Microsoft Corp., 68 USPQ2d 1195, 1200 (T.T.A.B. 2003) (same); Capital Project Management Inc. v. IMDISI Inc., 70 USPQ2d 1172, 1185 (T.T.A.B. 2003) (same); In re Ethnic Home Lifestyles Corp., 70 USPQ2d 1156, 1158 (T.T.A.B. 2003) (same); Interpayment Services Ltd. v. Doctors & Thiede, 66 USPQ2d 1463, 1466 (T.T.A.B. 2003) (same); In re Remacle, 66 USPQ2d 1222, 1224 (T.T.A.B. 2002) (same); In re Ruffin Gaming LLC, 66 USPQ2d 1924 (T.T.A.B. 2002) (same); In re Tower Tech Inc., 64 USPQ2d 1314, 1316 (T.T.A.B. 2002) (same); Callaway Vineyard & Winery v. Endsley Capital Group Inc., 63 USPQ2d 1919, 1921 (T.T.A.B. 2002). See, also In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009 (Fed. Cir. 1987) (“Whether a given mark is suggestive or merely descriptive depends on whether the mark ‘immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used,’ or whether ‘imagination, through, or perception is required to reach a conclusion on the nature of the goods.’”) The overwhelming case law authority holds that a mark that references an “ingredient” is generally held to be “merely descriptive,” rather than generic.

Further, in *In re America Online Inc.*, 77 USPQ2d 1618, 1623 (T.T.A.B. 2006) (“When we view the examining attorney's evidence, it is clear why applicant's marks were refused registration on the ground that the marks were generic.”), it would appear that the Examining Attorney handling the examination of several trademark applications being prosecuted by America Online Inc. and seeking the registration of related marks on the Principal Register nevertheless issued a refusal on the ground of genericness, thereby undercutting the Examining Attorney’s suggestion on the instant appeal that a genericness refusal-to-register should not be issued against a mark for which application is made for registration on the Principal Register, but instead only a refusal on the ground of mere descriptiveness would be appropriate unless, and until, an applicant amended its application to seek registration on the Supplemental Register.

Appellant has asserted in its principal *Appeal Brief* (at 7-8) that the Examining Attorney has taken inconsistent legal positions by initially refusing registration of Appellant’s mark on the ground that “GLASSFLAKE” was merely descriptive, then subsequently refusing registration of Appellant’s mark on the Supplemental Register as generic after Appellant amended its application for the purpose of seeking registration on the Supplemental Register, which would have caused the Examiner to withdraw the §2(e)(1) refusal-to-register. *America Online Inc.*, *supra*, 77 USPQ2d at 1623, makes clear that an Examining Attorney may procedurally issue a genericness refusal-to-register notwithstanding that an applicant may be seeking registration on the Principal Register.

Appellant has further contended, and continues to assert, that the prosecution history of Appellant’s trademark application evidences inconsistent views on the part of

the Examining Attorney as to whether Appellant's mark should be deemed "merely descriptive" or generic, thereby calling for resolution on the issue in Appellant's favor. *See, In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, *supra*, 828 F.2d at 1571, 4 USPQ2d at 1144 (doubt as to registrability should be resolved in favor of an applicant "on the theory that any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect."), *quoting In re Gourmet Bakers, Inc.*, 173 USPQ 565 (T.T.A.B. 1972). *See, also In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 393, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994) ("[D]escriptive terms describe a thing, while generic terms name the thing. . . . there is only a fine line between describing and naming." (quoting 1 *McCarthy*, §12.05[1] (3d ed. 1992))); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790, 217 USPQ 988, 993 (5th Cir. 1983) ("[t]he labels are more advisory than definitional, more like guidelines than pigeon-holes").

Finally, Appellant has suggested in its principal *Appeal Brief* (at 8) that the Board take into consideration that Appellant's "GLASSFLAKE" mark is registered in the European Community and that such foreign registration should be treated as probative evidence on the issue of whether Appellant's mark is truly generic. The Examining Attorney has countered that Appellant's corresponding European Community registration for "GLASSFLAKE" is "of little, if any, probative value." The Examining Attorney, as Appellant, has cited to *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007), for his contention that no meaningful value should be credited Appellant by the T.T.A.B. on the issue of genericness as a consequence of Appellant's European

Community trademark registration. The portions of Bayer extensively quoted by the Examining Attorney are submitted to be inapposite, in that the Examining Attorney's reliance on Bayer is addressed to "consumer perception among potential purchasers," rather than simply whether a given term may be capable of distinguishing the source of one's goods and therefore capable of acting as a trademark, which requires neither a determination of consumer perceptions nor other evidence of existing distinctiveness. Whether, in fact, Appellant's European Community registration should be seen as probative on the issue of genericness in the United States is submitted to be an open question awaiting definitive resolution. See, In re Bayer Aktiengesellschaft, 488 F.3d 960, 969, 82 USPQ2d 1828, 1835 *n.* 6 (Fed. Cir. 2007) ("We do not address here registrability determinations based on foreign registrations under Section 44 of the Lanham Act or registration proceeding under any applicable treaties or conventions."). Appellant's European Community trademark registration for "GLASSFLAKE" should be received by the Board as persuasive evidence that Appellant's "GLASSFLAKE" mark is not generic, but instead capable of distinguishing the source of Appellant's goods in commerce. Appellant is not relying upon its foreign registration as evidence of either consumer perceptions or distinctiveness, but solely for the limited purpose of evidencing that a foreign trademark office has inherently taken a position that is contrary to that of the Examining Attorney in the U.S.

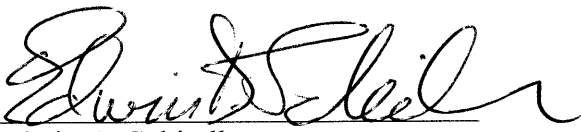
VI. Conclusion

In summation, it is respectfully contended that doubt concerning the question of

whether Appellant's "GLASSFLAKE" trademark is "merely descriptive" or generic should properly be resolved in Appellant's favor and that the Examining Attorney's final refusal-to-register under §23(c) of the Trademark Act, pertaining to the Examiner's contention that Appellant's "GLASSFLAKE" trademark is a generic term incapable of distinguishing source, should now be reversed by the Trademark Trial and Appeal Board by holding that Appellant's mark is "merely descriptive" and may eventually acquire distinctiveness, thereby justifying registration on the Supplemental Register. Such favorable action is respectfully requested and earnestly solicited.

Respectfully submitted,

GLASSFLAKE INTERNATIONAL INC.

By 
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February 8, 2011

The Commissioner for Trademarks is hereby authorized to charge the Deposit Account of Appellant's Attorney, Account No. 19-0450, for any fees which may be due in connection with the prosecution of the above-identified trademark application, but which have not otherwise been provided for.